

Applicants: Y.S. Fung et al.
Serial No.: 10/772,313
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REMARKS

This Amendment responds to the Office Action dated September 11, 2008, in which the Examiner rejected claims 1 and 3-17, all of the claims pending in the Office Action. In response to the Office Action applicants have amended claims 1 and 2, and by inference claims 3-17. Reexamination and reconsideration are respectfully requested in view of the foregoing amendments and the following remarks.

The Examiner has rejected claims 1-6 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative, (under 35 U.S.C. § 103(a)) as obvious over December. The Examiner contends that December's invention is directed to an anodic electrocoating composition. He states that December discloses that an anodic electrocoating composition that comprises an aqueous and base-salted dispersion of polymer with particle size between 0.05 to 5 microns (or 50 to 5000 nm), and that the December method uses an anodic electrocoating composition, has an electroconductivity between 0.1 to 5 mS/cm, has a pH of 7.9, and may contain a coalescing solvent in an amount between 0 and 15 wt%.

While December may broadly state that he uses an emulsion including particles having sizes ranging from 50 to 5000 nm, the reference simply fails to disclose or suggest a coating made from an emulsion having an average particle size between about 50 and 100 nm. Nor does the reference disclose the unique advantages following from the use of this particle size range, particularly its improved corrosion resistance.

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In addition, applicants' bath is substantially free of organic solvent. While December gives wide ranges in the disclosure, in the experimental section of his patent, the amounts used involve 5% even 30% or 50% organic solvent. Applicants submit therefore, that since December fails to disclose a method using an emulsion of including particles having an average size of about 50 nm or substantially excluding the use of an organic solvent, the pending anticipation rejection cannot stand. Applicants respectfully request that the Examiner reconsider and withdraw the subject anticipation rejection.

Regarding the obviousness rejection of claims 7-11 and 13-17, the Examiner asserts that the subject matter as a whole would have been obvious, and adjustment of variables is a matter within the capabilities of a person of ordinary skill in the art.

Applicants respectfully request reconsideration of this rejection and maintain that the claimed invention as a whole would not have been obvious to a person of ordinary skill in the art. December involves conditions that are much more severe and energy intensive than those involved in the claimed invention. In addition to increasing the cost of the production, the high temperature and voltage used in that method presents danger to plant employees, not a factor for those who practice the claimed invention.

Example 5 of December provides a case in point. It involves application of 50-100V for 2.2 minutes and a bath temperature of 700°F, while applicants' method, by comparison, involves 10-30 volts for 10-60 seconds at room temperature, which is about 70°F. Voltage of 50 to 100V and a bath temperature of 700°F presents a danger in the workplace, while the claimed invention works at room temperature and at a much lower voltage. A person of ordinary skill would not find it obvious to reduce the temperature, voltage, and reaction time by such significant amounts without the benefit

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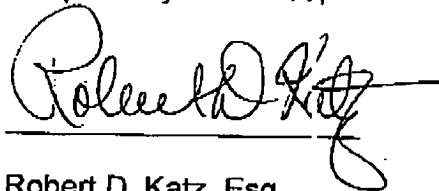
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of hindsight provided by applicants' disclosure. Applicants submit therefore that the claimed invention would not have been obvious in view of the process parameters provided by December, and respectfully request that the pending obviousness rejection of claims 7-11 and 13-17 be reconsidered and withdrawn.

The Director is authorized to change any fee required in connection with this response to Deposit Account No. 03-3125. If any extension is required in connection with the filing of this response, applicants hereby request same and authorize the fee therefor to be charge to Deposit Account No. 03-3125.

Dated: January 12, 2009

Respectfully submitted,



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